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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/532,191	04/21/2005	Bernardo Nicolas Sanchez	1081-16	8431
58388 7590 03/28/2007 GOWAN INTELLECTUAL PROPERTY 1075 NORTH SERVICE ROAD WEST SUITE 203 OAKVILLE, ON L6M-2G2 CANADA			EXAMINER WONG, JOSEPH D	
			ART UNIT 2168	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	DELIVERY MODE
3 MONTHS			03/28/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/532,191

Applicant(s)

SANCHEZ, BERNARDO NICOLAS

Examiner

Joseph D. Wong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 Feb. 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 April 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Drawings*

The drawings are objected to under 37 CFR 1.84 for being informal. For example, many of the figures use a font size smaller than 1/8 inch or 0.32 cm.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 2-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claims 2-7 and 9 are rejected for invoking the “or” clause because it is unclear whether each limitation is optional or mandatory to meet the claim.

Claims 2-3 and 5-9 are rejected for reciting a broad recitation followed by a narrower statement of the range/limitation. The phrase “includes” can be interpreted to be “for example” which is not limiting.

Claim 2 recites the broad recitation “traditional computer”, and the claim also recites “PDA” and “Internet enabled cellular phones” which is the narrower statement of the range/limitation.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP §

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2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949).

Claim 3 recites the broad limitation "document", and the claim also recites "Internet web page" and "word processor document" and "spreadsheet". The phrase "includes" can be interpreted as "for example" which is not limiting.

Claim 5 recites the broad limitation "file location and name, and/or with a URL addresses specific for said document" because the "and" appears limiting while "or" is not.

Claim 6 recites the broad limitation "document is stored on said user's computer" followed by a recitations of "a local storage device", "a remote storage device", "a network storage device", "Internet storage device", "an Application Service Provider".

Claim 7 recites searchable content and/or said relevant content includes "text", "highlighted text", "notes" annotations", "summaries", or "attachments". The phrase "includes" can be interpreted as "for example" which is not limiting.

Claim 8 recites "user defined data structure" includes "database of stored documents". The phrase "includes" can be interpreted to as "for example" which is not limiting.

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Claim 9 recites “created by” or “accessible by said user” and “wherein access to said relevant content is controlled by a permission based authorization system”. The “or” can be interpreted to be an optional alternative limitation.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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**Claim 10 is rejected for being directed towards nonstatutory subject matter.**

Claim 10 is directed to a “computerized information retrieval system”.

This claimed subject matter lacks a practical application of a judicial exception (abstract idea) since fails to produce a useful, concrete and tangible result.

Specifically, the claimed subject matter does not produce a tangible result because the claimed subject matter fails to produce a result that is limited to having real world value rather than a result that may be interpreted to be abstract in nature as, for example, a thought, a computation, or manipulated data. More specifically, the claimed subject matter provides for an INTENDED USE of “for displaying...”, “for marking...”, “for selecting and displaying...” which stops short of positively reciting the tangible result.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Sull et al.,  
US Pre-Grant Pub. No. 2002/0069218 A1, Filed 23 Jul. 2001, Pub. Date 6 Jun 2002,  
hereinafter Sull.**

Regarding claim 1, Sull shows a computerized method of information retrieval comprising: providing a computer displayable document having searchable content (interpreted to also include "multimedia file...images that contain text", abstract); marking said document (interpreted to include "tag or bookmark", abstract; Fig. 2), with a marking device (interpreted to include "bookmark", paragraph [53]; Fig. 2; [0172]), as being a relevant document ([376]); storing said relevant document in a user defined data structure (interpreted to include "bookmarked position", Fig. 12; [0211]); and conducting a search of a number of said relevant documents using a search engine to identify documents with a desired searchable content ([53]), Fig. 15; [214]); selecting, using a selection device (Fig. 2; [0172]), the documents identified as having said desired searchable content ([0051-0053]), and displaying said selected document (interpreted to include "query", "search", and "play", from Fig. 6, 3, 2).

Regarding claim 2, Sull shows a computerized method as claimed wherein a visible document is displayed, and said computerized method is operated by accessing a traditional computer (Fig. 45, item 4524), a PDA (Fig. 45, item 4522), an Internet enabled cellular phones (Fig. 45, item 4518). ([35])

Regarding claim 3, Sull shows a computerized method as claimed wherein said document is an Internet web page (Fig. 61), a word processor document (interpreted to be optional), a

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spreadsheet (interpreted to include a “matrix”, [380]), e-mail ([355, 365]) or a database file ([380]).

Regarding claim 4, Sull shows a computerized method as claimed wherein said document is stored in a fashion so that said searchable content is maintained so that a copy of an original image can be restored (interpreted to include “CD-ROM, DVD”, [70, 461]), or an updated image can be displayed (interpreted to include “recorded by PVR”, [368]).

Regarding claim 5, Sull shows a computerized method as claimed wherein said document is stored together with a file location and name, and/or with a URL addresses specific for said document ([172-173, 321]).

Regarding claim 6, Sull shows a computerized method as claimed wherein said document is stored on said user's computer, a local storage device, a remote storage device ([328]), a network storage device ([411]), an Internet storage device ([521]), or an Application Service Provider storage device ([290]).

Regarding claim 7, Sull shows a computerized method as claimed wherein said searchable content and/or said relevant content includes text (Fig. 15, items 1516, 1518), highlighted text ([349], [355], [363]), notes ([288]), annotations ([288]), summaries (Table 4, [366]), or attachments ([353]).



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Regarding claim 8, Sull shows a computerized method as claimed wherein said user defined data structure includes a database of stored documents. ([380-381])

Regarding claim 9, Sull shows a computerized method as claimed wherein the relevant content of said database was created by ([31-32]), or is accessible by (interpreted to be an optional alternative), said user, and wherein access (interpreted to be an optional alternative) to said relevant content is controlled by a permission based authorization system.

Regarding claim 10, Sull shows a computerized information retrieval system (title) comprising: a computer (interpreted to include "PC" or "Video Server", Fig. 18, items 1810, 1804) having a display (interpreted to include "PDA" or "facsimile machines", Fig. 18, item 1830; [269]) for displaying documents having searchable content (abstract); a marking device for marking document as being a relevant document (interpreted to include "bookmark", paragraph [53]; Fig. 2; [0172]); a storage device for storing said relevant document in a user defined database (Fig. 18, items 1806, 1812); and a search engine ([53]), Fig. 15; [214]) operatively connected (Fig. 18, items 1814, 1826) to said computer for conducting a search of a number of said relevant documents in order to identify documents with a desired searchable content (Fig. 15, items 1516, 1518; Fig. 2); a selection device for selecting and displaying the documents identified as having said desired searchable content. (interpreted to include "query", "search", and "play", from Fig. 6, 3, 2; [0172]; [0051-0053])

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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph D. Wong whose telephone number is 571-270-1015. The examiner can normally be reached on Mon.-Thur. 8AM - 5:30PM and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tim T. Vo can be reached on (571) 272-3642. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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